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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/020,980	12/19/2001	Jung-wan Ko	1293.1071D3	1189

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EXAMINER

PSITOS, ARISTOTELIS M

ART UNIT	PAPER NUMBER
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2653

DATE MAILED: 07/12/2004

24

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/020,980

Applicant(s)

KO ET AL.

Examiner

Aristotelis M Psitos

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-12 is/are rejected.
- 7) ☒ Claim(s) 8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4.21.22
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Applicants' response of 4/1/04 has been considered with the following results.

Information Disclosure Statement

The IDS of 11/16/03 has been reviewed. With the exception of the JP Office actions listed thereon, the documents (abstracts) have been reviewed and made of record.

The IDS of 6/5/02 has been received and entered. Note the examiner has only reviewed the pending applications # 1,3,4, and 6 since they have matured into US patents, 6683835, 6724705, 6744713, and 6741535.

US pending application #2 (09/610381) has been recently allowed and #5 (10/020945) is still pending. Due to the inability of retrieving the files no longer maintained at the same location as the Examining Corps the claims contained therein have not been reviewed.

Applicants' cooperation in maintaining a clear line of demarcation between the pending claims in this application and those in the other applications is respectfully requested. Applicants are in a better position to determine what invention they desire protection of in which application.

Claim Objections

1. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 8-11 have been renumbered as 9-12.

The application was originally filed with 8 claims. The above dated amendment cancels claims 1-7. The examiner has not been able to find authorization for canceling claim 8.

Claim 8 depends from a canceled claim and has not been considered.

Claim 12 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend

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the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 12 is written as a wherein clause – which the examiner interprets as a function of a system, i.e., a method limitation and NOT drawn to further limiting the structure of the parent claim.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

2. Claims 9-12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, claim 9 recites in line 8 “except for the RMA”. This finds no clear support in the specification as originally filed.

As filed, this invention (claims) is drawn to the description/specification with respect to figures 13-15. The appropriately disclosed write protect information is defined as (BP) 3. This is a single byte in the “0” field of the RMD area, however, the disclosure states that such a control flag/signal/byte write protects (“02b) everything except for the PCA. Hence there is not support for the newly introduced limitation with respect to “RMA”.

Also, dependent claim 10 attempts to define the write protection flag/signal/byte as (BP)2. This is not supported by the specification – again see the description with respect to figure 14, which shows the (BP) 2 not only as prior art but also as disc status information and not write protection.

Dependent claims fail to clarify the above and fall accordingly.

3. Claims 9-12 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter, which applicant(s) regard as their invention.

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As written, the claim attempts to control (write protect) the entire medium with the exception of the RMA. Hence, the RMA is NOT WRITE PROTECTED. If such is true, then the system WOULD PERMIT THE OVERWRITING/ERASING of this signal (because this is where the write protection signal is found) and hence, defeating the purpose of the disclosure.

Dependent claims 10-12 fail to clarify this and fall accordingly.

AS FAR AS THE REMAINING CLAIMS ARE UNDERSTOOD AND INTERPRETED BY THE EXAMINER THE FOLLOWING ART REJECTIONS ARE MADE.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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3. Claim 9 is rejected under 35 U.S.C. 103 as being obvious over Kuroda et al further considered Ugon or alternatively Kuroda et al further considered with Kono and both further considered with Ugon.

With respect to claim 9, Kuroda et al discloses a DVD disc, wherein the basic designated areas exist: lead in, lead out, user data area, RMA.

Applicants' use of the next term RMA and RMD DOES NOT DEFINE OVER Kuroda et al. The examiner concludes that both the claimed RMA and RMD limitations are inherently present, i.e. as stated in the reference the RMD is in an AREA provided appropriately. This is interpreted as the RMA of the claim (record management area): see figure 9, which depicts the RMD prior to the lead-in area, hence a RMD area, i.e., RMA. Looking at Kuroda et al, again, lead in, lead out, user data area is depicted, as is RMD: note figure 9 for instance. Hence, the examiner concludes that both the claimed terms RMA and RMD are inherently PRESENT. The PCA is considered inherently present.

Alternatively, with respect to the PCA the examiner concludes that such are well known in this environment as acknowledged by applicants/Kono in figure 9 depicts PCA prior to the lead-in area as being part of the prior art in this environment.

It would have been obvious to modify the base system of Kuroda et al with the PCA ability, motivation is to control the power of overall system using the record medium and setting such levels appropriately for recording/reproducing.

With respect to the desired ability of having write protection information stored, Ugon teaches the ability of having additional write protection code: see the description of the write protect at col. 4 lines 26-40.

It would have been obvious to modify the above combined references, Kuroda et al and Kono, or just Kuroda et al with the additional teaching from Ugon, motivation is to reduce the overhead at the block level and relocate a write protection ability in a data management field level. This would provide for an increased data block allocated to store information (data) and still provide for the write protection ability.

Furthermore, the placement of this information into the specified area noted in the claim is considered merely a relocation of this signal. The normal understanding of management area is that of an

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area to store/hold/designate information about the record medium indicative thereof. To place an indication of copy protect from one area into another is not considered patentable i.e., the placement of information control signals into various locations are well known see: McFerrin et al - at col. 9 lines 10 plus – placement of a write start signal at the appropriate location; Drews et al with respect to the description of figure 5, or again Ro et al/Ueda et al as stated in the previous Office action.

With respect to claim 8, if amended to be dependent upon claim 9, then from the above documents, which fail to specify that the disc be in a protective device, the limitations of claim 8 are considered inherently present.

4. Claims 10 & 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claim 9 above, and further in view of either Heo or Maeda et al ('759).

In this rejection, the examiner interprets the location not as (BP) 2 but as disclosed (BP) 3.

The particular bit location, bp3, bp0, etc. as found in this claim is considered to be obvious over the DVD formats of either Heo or Maeda et al – both of which indicate such nomenclature is known when identifying sections of the dvd formats, see figures 8b, 9d, 16 17b, 18b and c in Heo which uses such bit designation for a plurality of uses – note in particular the use for designating attributes of the information.

Also, Maeda et al with respect to the DVD control data and TOC nomenclature.

It would have been obvious to modify the base system as identified above with respect to claim 1 and further use the nomenclature/language of DVD formats and place the control information at the desired location.

Placing of control information at the particular bit positions is considered merely a selection from a plurality of alternative equivalents, i.e., a design expediency as long as such does not conflict with previously used bit positions.

5. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over the art as relied upon with respect to claim 9 above and further with Official notice.

With respect to claim 12, the examiner interprets such as a functional/method limitation, which flows from, follows when the above combined record medium is used in the appropriate environment.

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Hence since recording/reproducing systems as well known (Official notice is taken thereof), when the above-modified record is placed in such, this function follows.

It would have been obvious to modify the above noted references with the well-known rec/repr. devices, motivation is to actually use the record for its intended purpose.

Response to Arguments

Applicant's arguments with respect to claims 9-12 have been considered but are moot in view of the new ground(s) of rejection.

Applicants' attention is also drawn to Bakx (5072435) who teaches the ability of having an appropriate indication (read only) in an area prior to the li and pa – at col. 7 lines 25-45, i.e., teaching of a control signal (write inhibit if you will) in an area prior to the li.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Hard copies of the application files are now separated from this examining corps; hence the examiner can answer no questions that require a review of the file without sufficient lead-time.

Any inquiries concerning missing papers/references, etc. must be directed to Group 2600 Customer Services at (703) 306-0377.

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Any inquiry concerning the merits of this communication or earlier communications from the examiner should be directed to Aristotelis M Psitos whose telephone number is (703) 308-1598. The examiner can normally be reached on M-Thursday 8 - 4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William R. Korzuch can be reached on (703) 305-6137. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Aristotelis M Psitos
Primary Examiner
Art Unit 2653



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